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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/588,041

08/01/2006

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HUBR-1298

3661

24972 7590 08/07/2009  
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EXAMINER

MESH, GENNADIY

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,041	<b>Applicant(s)</b> MORARU ET AL.	
	<b>Examiner</b> GENNADIY MESH	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20 - 38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20 - 38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's amendment filed on May 21, 2009 is acknowledged.

Claims 1-19 have been cancelled by Applicant. Claims 20 - 38, previously examined, are active.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 20 - 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albrecht et al.(WO 00/77058 - note that US 6,777,517 as equivalent of WO 00/77058 will be used in rejection as a English translation) in view of Shendy et al.(2003/0187101).

The rejection is adequately set forth in paragraph 2 of the action mailed on February 25, 2009 and is incorporated here by reference.

### ***Double Patenting***

3.1 Claims 20 - 38 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1- 20 of U.S. Patent No. 6,777,517 in view of Shendy et al.( 2003/0187101).

The rejection is adequately set forth in paragraph 3.1. of the action

mailed on February 25, 2009 and is incorporated here by reference.

3.2. Claims 20 - 38 are directed to an invention not patentably distinct from claim 1-20 of commonly assigned US Pat. 6,777,517 as it was discussed above ( see paragraph 3.1.).

3.3. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned US Pat. 6,777,517, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

3.4. Claims 20 -38 are rejected under 35 U.S.C. 103(a) as being obvious over US Pat. 6,777,517 in view of Shendy et al.( 2003/0187101) as it was explained above( see paragraph 2 above).

The rejection is adequately set forth in paragraph 3.4 of the action mailed on February 25, 2009 and is incorporated here by reference.

### ***Response to Arguments***

4. Applicant's arguments filed May 21, 2009 have been fully considered but they are not persuasive.

4.1. Applicant's arguments related to Claims 20 - 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albrecht et al.(WO 00/77058 - note that US 6,777,517 as equivalent of WO 00/77058 will be used in rejection as a English translation) in view of Shendy et al.( 2003/0187101) based on following statement:

a) " Shendy discloses polyalkylene oxide residues which act as defoamers for foaming dispersant compositions. The dispersants of Shendy cited by the Examiner (par. [0067]) are quite similar to elements of structural unit 1 of the present application; however, it cannot be ascertained from the cited passage that the dispersants described therein are used in the form of copolymers according to the present invention. These polyalkylene oxide residues are not covalently bonded to other non-polyalkylene oxide residues. "

and

b) " Furthermore, a person of skill in the art would not be motivated by the cited reference to integrate the defoamers disclosed by Shendy in the fluidizers disclosed by Albrecht by covalent bonding as an element of copolymers to arrive at the subject matter of the present application".

In response for Applicant's arguments, it should be pointed out, that difference between copolymer claimed by Applicant and copolymer disclosed by Albrecht is that polyalkylene oxide in side chain - **covalently bonded**- has lower degree of polymerization, specifically up to 200.

However, Shendy teach copolymer of very similar structure as it claimed by applicant, wherein polyalkylene oxide **residues is covalently bonded** to second unit of polymer structure. It also clear, that polyalkylene oxide used by Shendy may have degree of polymerization more than 400 ( see [0072], note that value of :  $t > (s+u)$ ), which is same degree of polymerization as it claimed by Applicant.

Also, Shendy provide motivation or guidance to one of ordinary skill in the art to use polyalkylene oxide moiety that functions as a defoamer( see [0028]) incorporated in insoluble defoamer **dispersant** compositions, because this dispersant can provide an admixture for cementations compositions **that is stable over time**. The resulting admixture has long term storage stability so that the admixture does not need to be mixed prior to use at the work site. ( see rejection , paragraph 2 of the action mailed on February 25, 2009).

For reasons above Applicant's arguments were found unpersuasive.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GENNADIY MESH whose telephone number is (571)272-2901. The examiner can normally be reached on 10 a.m - 6 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272 1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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